

Remarks

Reconsideration of the rejection Claims 1-8 and 31-36 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,372,252 to Blume et al. (Blume) in view of U.S. Patent 5,032,406 to Dansereau et al. (Dansereau) is respectfully requested.

The present invention is directed to a particulate guaifenesin composition comprising an agglomerated mixture of guaifenesin particles and a polyvinylpyrrolidone binder wherein the composition comprises from about 85% by weight to about 97.5% by weight guaifenesin by sieve analysis, based on the total weight of the composition, less than about 30% by weight of the particles of the composition exhibit a particle size of greater than about 425 micrometers and greater than about 80% by weight of the particles of the composition exhibit a particle size of greater than about 45 micrometers (Claim 1) Claim 31 is similar to independent Claim 1, but further requires that the "composition is capable of being compressed into a compressed dosage form without addition of other components...".

With regard to the limitations of the composition the preceding Office Action acknowledges (first sentence on page 3) that "Blume fails to teach granulation of guaifenesin with polyvinylpyrrolidone [PVP]". The Office Action continues on page 6, line 10 that "instant rejection cites Dansereau for the addition of PVP and not particle sizes".

Thus, with regard to the claimed composition the particle size of Blume must teach or make obvious the recited limitations.

Blume clearly does not teach the particle size limitations of the claimed composition.

In order to avoid any confusion regarding the equivalence of sieve size (by number) or the size of the particle passing therethrough (whether by millimeter or micron), Applicant's attach Perry's Chemical Engineers' Handbook, Sixth Edition, McGraw-Hill Book Company, New York, 1984, pp. 21-15, Table 21-6 presents in

tabular form the sieve size designation (by number and its equivalent opening size, *i.e.*, the size of the particle that will pass or be retained by said sieve) Therefore, although the Office Action states (page 4, second full paragraph "With respect to the claimed particle sizes, Blume teaches that "not more than 10% retained on a 10-mesh screen (greater than 850 microns)", this is an error. Blume at column 8 does state that "the dried granulation may be passed through a mill fitted with a suitable screen size, so that not more than about 30% of the resulting granulation comes through a 100 mesh screen and not more than about 10% of the resulting granulation is retained on a 10 mesh screen " (lines 19-23) However, as can be seen by comparing the tabular sieve designation mesh size in the attachment to Blume, a number 10 screen has 2.00 mm or 2000 micron openings, not 850 microns as suggested by the Examiner. The 100 mesh screen is indeed 150 microns, Thus, what Blume does teach is that about 60% of his particle size distribution lies within the range of 150-2000 microns. Whereas Blume permits 10% of his particles to be greater than 2000 microns, the claimed range restricts the composition such that only 30% is greater than 425 microns (425 micrometers) Moreover, in Blume about 30% of the granulation passes through a 100 mesh screen (150 microns) wherein in the claimed invention greater than 80% of the particles exhibit a particle size greater than about 45 microns (equivalent to a 325 mesh screen) Therefore, the Examiner is correct in that Blume does not state what his particle size distribution is below 150 microns (or above 425 microns) If followed to a reasonable conclusion Blume provides no teaching of any particle size distribution to meet the lower (or upper) limit of the claimed invention. For example, with reference to the attached "Standard Test Sieve Designation" 30% of Blume's particles may pass through the 100 mesh screen (150 μm), and also pass through all the screens listed on the Table including the number 400 mesh screen (38 μm), and thus, there is no indication that at least 80% would be retained on the 45 micron screen as instantly claimed. The Examiner has expressly conceded that as Dansereau is cited only for the addition of PVP and not for its particle size no further discussion of Dansereau is necessary.

Thus, it can be seen that Blume does not possibly teach the claimed limitations and as these are limitations of the composition itself, *i.e.*, not process steps as argued by the Examiner (*e.g.*, See page 6, first full paragraph), the proposed combination of Blume and Dansereau cannot possibly establish a *prima facie* case of obviousness for the claimed invention. Because the claimed compositional properties also effect the performance properties of the composition, the limitations of Claim 31, cannot possibly be met by a particle size distribution as in Blume, as Blume has an unknown lower limit, and in which upper limit greatly exceeds the upper claimed size in the instant invention by orders of magnitude.

Moreover, Applicant's description of the prior art, page 2, lines 5-14 of the specification shows that prior art compositions had unacceptably high friability and unacceptably low hardness and tend to exhibit "capping", that is cracking and separation of part of the dosage form from the remaining body of the dosage form. It is further described at page 3 of the specification beginning at line 5 that the guanifenesin containing composition of the presently claimed invention provides improved robustness and flexibility with regard to processing conditions when the particle size distribution is such that less than about 30% by weight exhibit a particle size greater than about 425 micrometers and greater than about 80% by weight of the particles exhibit a particle size of greater than about 45 micrometers; See page 2, line 29 through page 3, line 13 of the instant specification.

The Examiner has cited In re Aller, 105 USPQ 233, 235 (CCPA 1955) for the proposition that "generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art, unless there is evidence indicating such concentration or temperature is critical". Applicant is claiming neither concentration nor temperature, but rather particle size distribution which defines the subject matter of the composition itself. As shown above, such subject matter is not taught in the proposed combination of Blume and Dansereau. Moreover, In re Peterson, 65 USPQ 2d at 1382 is also inapposite. Applicant, through the analysis provided above, show that Blume does not teach nor suggest the range of particles sizes set forth in the instant claims. The

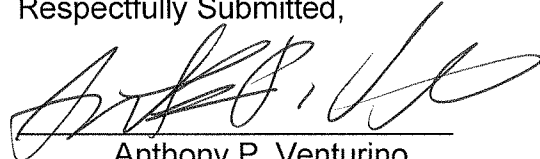
proposition of Peterson is that it would be obvious to optimize the parameters within a disclosed set of the teachings of the prior art but here the teachings of the prior art do not encompass the claimed invention. For this reason there is no requirement for Applicant to show unexpected advantage in the particle size range, as the particle size range *per se* defines the composition sought to be patented. For all the foregoing reasons withdrawal of all rejections is respectfully requested.

New claim 37 finds support in the original disclosure, for example in the specification at page 2, line 29 to page 3, line 14, page 4, lines 12-18, line 24 to page 5, line 18 and page 13, lines 9-12. Accordingly, the new claim does not raise the issue of new matters and is both novel and unobvious over the cited references.

Applicant has attempted to initiate a personal interview with the Examiner prior to the filing of the foregoing Amendment together with a Request for Continued Examination (RCE) in a telephone interview conducted on October 24, 2007. The Examiner has been and remains unable to grant the interview prior to the expiration of the response period on October 26, 2007.

Accordingly, Applicant has filed an RCE and respectfully requests suspension of examination of the RCE for three (3) months such that the interview can be conducted, and the undersigned respectfully requests that the Examiner contact him by telephone at 202.785.0100 for the purpose of conducting such interview, should the Examiner reach the application for action on the merits prior to conducting such interview.

Respectfully Submitted,



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